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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/192,766 11/16/98 BREEDIS J 101.931

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IM62/0717

EXAMINER

IP, S

ART UNIT

PAPER NUMBER

1742

DATE MAILED:

07/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P r i d r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5/5/2000.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

- ☒ Claim(s) 1, 3 - 18 is/are pending in the application.
- Of the above claim(s) 15 - 18 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3 - 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1742

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14 are, drawn to copper base alloy product, classified in class 148, subclass 433+.
 - II. Claims 15-18 are, drawn to a process for the manufacture of a copper alloy product, classified in class 148, subclass 554+.
2. The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make other and materially different product such as aluminum base alloy product.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Art Unit: 1742

4. Applicant's election with traverse of Group I, claims 1-14 in Paper No. 4, filed May 5, 2000, is acknowledged. The traversal is on the ground(s) that as set forth in instant remarks, second full paragraph of page 4. This is not found persuasive because there is no evidence the claimed copper alloy composition is critical to the process.

The requirement is still deemed proper and is therefore made FINAL.

5. This application contains claims 15-18 are drawn to an invention nonelected with traverse in Paper No. 4, filed May 5, 2000. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- A. Determining the scope and contents of the prior art.
- B. Ascertaining the differences between the prior art and the claims at issue.
- C. Resolving the level of ordinary skill in the pertinent art.
- D. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

Art Unit: 1742

commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 5-311292 (PTO-1449, abstract).

10. Claims 1, 3 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 4362579 to Tsuji (PTO-1449, claim 2), JP 4354843 (PTO-1449, abstract), JP 6184679 (PTO-1449, page 2 - [0004]), JP 59126742 (PTO-1449, abstract), or JP 7126779 (PTO-1449, page 2, col. 1).

11. Claims 1, 3-4 and 6-14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 05311294 (abstract), JP 05311295 (abstract), or JP 06228684 (abstract).

12. Claims 1, 3-5, 7-9 and, 14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 04231430 (abstract), JP 05059467 (abstract), or JP 06299275 (abstract).

13. Claims 1 and 3-14 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06179932 (abstract).

14. The cited references disclose the features substantially as claimed. The disclosed features include the claimed Cu base alloy compositions. The difference between the reference(s) and the claims are as follows: Some references do not disclose the claimed Ni to P ratio. However, it is

Art Unit: 1742

well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, In re Cooper and Foley 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. In re Austin, et al., 149 USPQ 685, 688.

15. Some references may contain additional optional alloying elements, but the instant transitional expression "consisting essentially of" includes the optional alloying elements from the cited references. When applicant contends that modifying components in the reference composition are excluded by the recitation of "consisting essentially of" applicant has the burden of showing the basic and novel characteristic of his/her composition - i.e. a showing that the introduction of these components would materially change the characteristics of applicant's composition. In re De Lajarte, 337 F 2d 870, 143 USPQ 256 (CCPA 1964) and Ex parte Davis, et al., 80 USPQ 448, 450 (PTO Bd. App. 1948).

Response to Arguments

16. Applicant's arguments filed May 5, 2000 have been fully considered but they are not persuasive.

17. Applicants argue that the Ni/P ratio of the JP 5-311292 reference is much broader than the claimed ratio range. However, page 8, lines 192-193 of the instant specification does not show

Art Unit: 1742

the claimed Ni/P ratio is critical to the brass alloy strength and electrical conductivity.

Nonetheless, the claimed Ni/P range is disclosed by said reference and the said ratio is anticipated by sample 13 (see page 5 of JP 5-311292).

18. Applicants argue that the upper limit of Si content of Tsuji reference is much higher than the claimed range. But, the claimed Si range is anticipated by said reference at 0.1 wt.%.

19. Applicants argue that Tsuji does not disclose the Ni/P ratio. However, said reference has Ni and P proportions overlapping the claimed ranges. Furthermore, selecting a range in a known range by optimization for the best results is within ambit of ordinary skill artisan, see *In re Aller*, 105 USPQ 233 and *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

20. Applicants' responses to JP 4-354843, JP 6-184679, ~~JP 5-126742~~, JP 7-126779, JP 5-311294, JP 5-311295, JP 4-231430, JP 6-179932, and JP 6-228684 are noted. The examiner reiterates the response as set forth in item 19 above.

21. Applicants argue that the Be upper proportion of JP 04231430 is higher than the claimed range. However, the instant 0.1 wt.% Be is anticipated by the said reference.

22. Applicants argue that JP 5-59467 excludes Ni. The examiner disagrees. The reference discloses Ni as an optional element.

23. Applicants' argument with respect to JP 6-299275 is noted. The examiner reiterates responses as set forth in items 18-19 above.

Conclusion

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

Art Unit: 1742

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See MPEP § 2163.06 (a) and 37 C.F.R. § 1.119.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (703) 308-2542. The examiner can normally be reached Monday to Friday from 6:30 A.M. to 2:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy King, can be reached on (703)-308-1146.

The facsimile phone number for "After Final Official Papers" is (703) 305-3599, "All Other Official Papers" is (703) 305-7718, and "Unofficial Papers" is (703) 305-7719. When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



SIKYIN IP
PRIMARY EXAMINER
ART UNIT 1742

S. Ip
July 13, 2000